

U.S. Application No. 10/691,352, filed October 22, 2003
Response AF dated November 7, 2006
In Reply to Office Action Made Final of September 7, 2006

REMARKS

Claims 44-94 are pending. Claims 44-94 were rejected in the Office Action Made Final dated September 7, 2006 ("Office Action Made Final").

For completeness in response and to focus the present response, Applicants incorporate the previous response of August 24, 2006 herein in its entirety.

Claims 44, 45, 49-51, 54, 55 and 59-63 stand rejected on the grounds of nonstatutory obviousness-type double patenting. A timely filed terminal disclaimer is enclosed. Applicants respectfully draw the attention of the Examiner to the Statement under 37 C.F.R. § 3.73(b) and Power of Attorney filed on November 6, 2006. It is believed that Applicants' representative, Michael T. Cruz, Reg. No. 44,636, is authorized to sign the enclosed timely filed terminal disclaimer.

Claims 44-47, 49-57, 59-61, 64,65, 67-70, 72-75, 77-80, 82-85 and 87-93 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 4,621,189 ("Kumar"). Applicants respectfully traverse the rejection as set forth below.

To maintain an anticipation rejection, each and every element as set forth in the claims must be described in Kumar. It is respectfully submitted that Kumar does not describe each and every element as set forth in independent claim 44, for example.

Claim 44 recites, in part:

"a device housing having a normal closed condition defining an interior space within the device housing, and having an interior electrical connector within said interior space" and

"said device having an open condition providing access to said interior space while said device housing is in said open condition to enable connection with said interior electrical connector of a peripheral device equipping the device to perform a new function".

Recessed Pin Socket

As alleged by the Examiner, recessed pin sockets 28 are alleged to be "an interior electrical connector". Kumar at col. 3, line 29 refers to "recessed pin sockets 28". However, the recessed pin sockets 28 of Kumar are not "within said interior space" as set forth in claim 44. Claim 44 recites,

in part, “a device housing having a normal closed condition defining an interior space within the device housing”. FIG. 2 shows an alleged open condition and reveals the “interior space” defined by the normal closed condition of the device housing. It is apparent from FIG. 2 that the recessed pin sockets 28, *as the name implies*, are recessed into the hand held main body portion 12 such that the recessed pin sockets 28 are not “within said interior space” as set forth in claim 44. In fact, the recessed pin sockets 28 are under the alleged interior space and thus do not meet each and every element as set forth in claim 44. Thus, the recessed pin sockets 28 as configured in Kumar do not meet the elements as recited in claim 44.

Since Kumar does not describe each and every element as set forth in claim 44, Kumar cannot anticipate claim 44. It is therefore respectfully requested that the anticipation rejection be withdrawn with respect to claim 44.

New Function

The Examiner is alleging that Kumar at FIG. 1 shows the “normal closed condition defining an interior space within the device housing” and that Kumar at FIG. 2 shows “said device having an open condition ... to enable connection with said electrical connector of a peripheral device equipping the device to perform a new function” as set forth in claim 44.

If FIG. 1 of Kumar is the alleged “normal closed condition”, then the hand held data entry terminal 10, in the normal closed condition, already provides optical scanning (as alleged by the Examiner) via the scanning head 14. So how does the hand held data entry terminal 10 having an open condition enable connection to perform a new function? The normal closed condition already provides optical scanning (as alleged) via the scanning head 14. So how does the open condition enable connection to perform a new function? In fact, it does not.

Since Kumar does not describe each and every element as set forth in claim 44, Kumar cannot anticipate claim 44. It is therefore respectfully requested that the anticipation rejection be withdrawn with respect to claim 44.

General-Use Dictionaries

The Examiner relied upon a general-use dictionary definition of “enable” as “to make

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possible”.

Terms in the claims are supposed to be interpreted as would be interpreted by one of ordinary skill in the art.

On the other hand, the general-use dictionary provides abstract definitions in a vacuum which may or may not be appropriate in view of the claimed invention as understood by one of ordinary skill in the art.

Does the Examiner believe that a general-use dictionary such as Merriam Webster provides definitions that always capture the scope of the claim terms as understood by one of ordinary skill in the art?

Applicants have reviewed the definitions of enable in the Merriam Webster dictionary. There are multiple definitions.

What was the basis for choosing one definition over the others?

Furthermore, not only did the Examiner pick and choose one definition of “enable” over other definitions of “enable”, but the Examiner even picked and chose terms within that definition. Applicants note that the definition chosen by the Examiner was “to make possible, practical, or easy”. In the Office Action, the Examiner cut off the definition after “possible”

What was the basis for choosing, within one definition, one word over another word?

Is there some basis for alleging that such a definition would be so interpreted by one of ordinary skill in the art? Determining the interpretation by one of ordinary skill in the art is an objective determination. What were the objective principles that the Examiner relied upon in determining how one of ordinary skill in the art would interpret the claimed invention as set forth in claim 44.

Applicants seek clarifications to these issues raised by the action of the Examiner picking and choosing a partial definition from a plurality of definitions from a general-use dictionary. What is the support for such a definition being used by one of ordinary skill in the art?

Arguendo, Only for the Purposes of Argument

Even if the Examiner’s alleged definition of “enable” as “to make possible” is used (for the

sake of argument only), the interpretation of Kumar to read on the elements as set forth in claim 44 does not make sense.

Kumar at FIG.1 is alleged to show “a normal closed condition” and Kumar at FIG. 2 is alleged to show “an open condition”. So according to the allegation by the Examiner, in FIG. 1 (i.e., the alleged “normal closed condition”), the hand held main body portion 12 already provides optical scanning (as alleged by the Examiner). The Examiner is also alleging, in FIG. 2, that the open condition enables connection to perform a new function (i.e., allegedly again, optical scanning).

If the hand held main body portion 12 of Kumar already provides optical scanning (alleged) in a “normal closed condition” as illustrated in FIG. 1 of Kumar, then why would one of ordinary skill in the art place the hand held main body portion 12 of Kumar in an “open condition” to enable (allegedly “to make possible”) connection to perform optical scanning (alleged “new function”)?

Or simply, if in “closed condition”, the main body portion 12 of Kumar already provides optical scanning, why would one of ordinary skill in the art place the main body portion 12 in “open condition” to make possible connection to perform optical scanning?

It makes the open condition unnecessary if the closed condition already provides optical scanning (as alleged by the Examiner).

It is believed that Kumar does not support such an interpretation. Furthermore, one of ordinary skill in the art would not interpret the claim terms in view of Kumar in such a manner.

Applicants respectfully submit that Kumar does not describe that claimed invention as set forth in claim 44.

It is therefore respectfully requested that the anticipation rejection be withdrawn with respect to claim 44 and its rejected dependent claims (i.e., claims 44-47).

Language similar in some respects to the language recited in claim 44 can be found in at least some of the claims rejected under an anticipation rejection based on Kumar. It is respectfully requested that the Examiner reconsider the anticipation rejection of claims 49-57, 59-61, 64,65, 67-70, 72-75, 77-80, 82-85 and 87-93.

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Claims 48, 58, 62, 63, 66, 71, 76, 81, 86 and 94 stand rejected under 35 U.S.C. § 103(a) as being obvious over Kumar and another cited patent document.

Applicants have pointed out some of the teaching deficiencies of Kumar and respectfully submit that the other cited patent documents do not make up for the teaching deficiencies of Kumar.

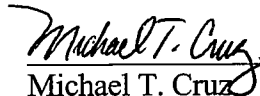
It is respectfully requested that the Examiner reconsider the obviousness rejections based, in part, on Kumar with respect to claims 48, 58, 62, 63, 66, 71, 76, 81, 86 and 94.

In view of at least the foregoing, it is respectfully submitted that the pending claims 44-94 may be in condition for allowance. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge additional fees or credit overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Date: November 7, 2006

Respectfully submitted,


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Attachment: Terminal Disclaimer (2 Pages)